

In re Goecke
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Filed: 9/29/2003
Amendment A and Response to Office Action Dated March 21, 2005

REMARKS

Applicant wishes to thank the Examiner for the consideration given this case to date and the courtesy of the telephone interview conducted June 29, 2005. Applicant has now had an opportunity to carefully consider the Examiner's action, and respectfully submits that the application, as amended, is now in condition for allowance. As filed, claims 1-10 were pending. With the amendments above, claims 1 – 7 and 9 – 12 remain pending.

THE EXAMINER'S ACTION

In the Office Action dated March 16, 2005, the Office:

- 1) rejected claims 1-10 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the claimed invention;
- 2) rejected claims 1-6 and 8-10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,686,170 to Condon et al. ("Condon");
- 3) rejected claims 1-7 and 9-10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,440,538 to Ungar ("Ungar "); and
- 4) rejected claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over Condon in light of Ungar.

THE TELEPHONIC INTERVIEW CONDUCTED JUNE 29, 2005

In accordance with MPEP section 713.04 the following summary is provided:

(A) a brief description of the nature of any exhibit shown or any demonstration conducted.

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Applicant provided a draft response with suggested claim language to overcome the rejections of record.

(B) identification of the claims discussed.

All claims including versions of newly presented claims were discussed.

(C) identification of specific prior art discussed.

The prior art applied to the claims in the Office Action dated March 21, 2005 was discussed.

(D) identification of the principal proposed amendments of a substantive nature discussed.

The principal proposed amendments include the attachment of a polymer layer to an adhesive layer and whether “attached” means “directly attached”. Agreement was not reached.

(E) the general thrust of the principal arguments of the applicant and the examiner.

The applicant argued that the references were non-analogous in the first instance and that they failed to teach the limitations claimed. Specifically, Condon failed to teach at least the Shore A Hardness scale, and Ungar failed to teach that the wear resistant layer was removable. The Examiner advised that he would review the Shore scales and potentially withdraw Condon based on the findings, and that although unpersuaded by the verbal arguments against Ungar, he would consider written remarks on the subject.

(F) a general indication of any other pertinent matters discussed.

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None.

(G) the general results or outcome of the interview.

Agreement was not reached on the allowability of the claims.

AMENDMENT TO THE SPECIFICATION

Applicant's amendments to the TITLE and ABSTRACT are believed to more closely align these portions of the specification with the claims and are not believed to introduce any new matter.

AMENDMENTS TO THE CLAIMS AND NEWLY ADDED CLAIMS

Applicant's amendments and newly added claims are intended to clarify the structure that Applicant claims, cure antecedent basis problems, and correct minor typographical errors.

Support for these amendments may be found in Figure 1 and in the specification. Support for the newly added claims may be found in the originally filed claims, Figure 1, and the specification including the chart at numbered paragraph 0018. These amendments are not believed to introduce new matter.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Applicant has amended the claims noted and now believes that the rejections under 35 U.S.C. § 112, second paragraph have been overcome. Re-consideration and withdrawal of the rejection in light of the amendments above is respectfully requested.

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REJECTIONS UNDER 35 U.S.C. § 102(b):

Claims 1-6 and 8-10 are not anticipated by Condon

Condon fails to anticipate the current claims because it discloses and teaches a multilayered sign blank – art unique and distinct from Applicant's claimed adhesive tape. Even if the multilayered sign blank in Condon does contain a layer of adhesive that permits the multilayered sign blank to be adhered to a substrate, the mere presence of that adhesive does not transform the multilayered sign blank into an adhesive tape. Further, there is no disclosure or teaching within Condon to indicate that its multilayered sign blank is or may be construed to be an adhesive tape as claimed by Applicant. Condon therefore is non-analogous art vis-à-vis Applicant's claims directed to an adhesive tape and, as such, the rejection is improper and should be withdrawn.

The Office will appreciate that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (MPEP § 2131).

Condon also fails to anticipate the claims. For example, claim 1 calls for an adhesive tape comprising a polymer layer and a layer of adhesive attached to that polymer layer. Condon fails to teach or fairly disclose this structure. Specifically, the Office concludes that Condon's disclosure of a polymer layer (12) and an adhesive layer (30) anticipates these elements. Closer inspection reveals that the layers taught by Condon are clearly not attached to each other (see Figures 6 and 7 and column 6 lines 14-25, showing that the adhesive layer (30) is not attached to the polymer layer (12), but rather to an intermediate layer (24)). Because the polymer layer and

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the adhesive layer are not attached, Condon fails to anticipate the claims and the rejection should be withdrawn.

Condon also fails to anticipate the Shore hardness requirements of claims 1 and 9.

Applicant's claim 1 clearly calls for a "Shore A Hardness of between about 92 and 100" for the polymer layer within the adhesive tape and claim 9 calls for a "Shore A Hardness of between about 93 and 97" for the polymer layer within the adhesive tape. However, Condon discloses a polymer layer that has a specified Shore D hardness or Shore C hardness (column 5, lines 40-54) and does not disclose any Shore A hardness values of the polymer layer. Should the Office argue equivalency of the different Shore scales, Applicant respectfully requests this be clearly indicated in the record and appropriately supported.

Therefore, Condon fails to anticipate Applicant's claims and the rejections should be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 102(e):
Claims 1-7 and 9-10 are not anticipated by Ungar

Ungar fails to anticipate the current claims because it discloses and teaches an abrasion resistant laminate used to cover countertops and table tops – teachings far removed from Applicant's claimed adhesive tape. There is no disclosure or teaching within Ungar to indicate that its abrasion resistant laminate is or may be construed to be an adhesive tape as recited in the presently pending claims. Ungar therefore fails to anticipate the very nature of Applicant's claimed invention – an adhesive tape – and the rejection should be withdrawn.

Ungar fails to anticipate the claims, as amended. For example, claim 1 calls for a polymer layer having a thickness between about 0.020" to 0.065" attached to a layer of adhesive.

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The Office has conceded that Ungar fails to teach the thickness limitation, thus, Ungar does not anticipate claim 1, and the rejection is believed overcome.

Ungar also fails to anticipate the textured surface requirement of Applicant's claim 3. Ungar notes the use of fillers and additives to the polymer layer in the laminate but makes no mention of the textured nature of the polymer layer's surface. In rejecting Applicant's claim 3, the Office flatly stated a belief that the addition of fillers and additives to a polymer would automatically create a textured surface. However, Applicant discovered no teaching within Ungar that relates to any texture of the polymer layer. In fact, the resultant surface texture of a processed polymer is at least partly dependent upon the processing methods used, and the Office has not shown why the addition of any filler or any additive to a polymer in the present case would automatically create a textured surface. Because there appears to be no support for the Office's position, Applicant respectfully submits that the textured surface in Applicant's claim 3 is not disclosed within or anticipated by Ungar and the rejection should be withdrawn.

Ungar fails to anticipate claims 7 and 10. First, Ungar discloses the use of neither a pressure sensitive adhesive in general nor the specific use of a rubberized double sided tape. Applicant's claim 10 calls for an adhesive tape where the adhesive is a pressure sensitive adhesive. However, though Ungar does contain an adhesive layer, there is no teaching or suggestion that the adhesive layer may be a pressure sensitive adhesive. The Office refers to column 8, lines 14-19 as evidence that Ungar teaches the use of a rubberized pressure sensitive adhesive. However, Applicant respectfully disagrees with this characterization of the reference – the adhesives listed in that section of Ungar are taught to be merely adhesives, not pressure

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sensitive adhesives. Because Ungar does not disclose the use of any pressure sensitive adhesive as the adhesive layer, Ungar does not anticipate claim 10 and the rejection should be withdrawn.

Ungar also fails to anticipate claim 7 reciting that the "adhesive comprises a rubberized double-sided tape." Applicant notes the Office's tortured definition of 'double-sided tape' and respectfully submits that the Office's proposed meaning of 'double-sided tape' is repugnant to that phrase's well known meaning in the art. The Office has taken the position that any adhesive applied to a substrate constitutes "a double-sided tape" because the adhesive has two adhesive surfaces on opposing sides. However, the claims do not call for a double-sided adhesive – rather the claims call for a double-sided tape. As an example definition, a double sided tape includes a substrate having adhesive on opposing or both surfaces. Conversely, by the Office's definition, all adhesive tapes would be double-sided adhesive tapes due to the presence of an adhesive layer which, by itself, has two adhesive surfaces, one of which is attached to the tape's own substrate and the other of which is exposed and allows the tape to adhere to a surface. As this definition renders the term, 'double-sided tape' meaningless, it cannot be correct. Applicant therefore respectfully submits that as the Office's definition of double-sided tape falls, so does the rejection based thereon. Therefore, Ungar does not anticipate claim 7 and the rejection should be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103(a):
Claims 1-10 are not obvious combinations of Condon in view of Ungar

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Condon in view of Ungar. Because the deficiencies within Condon are not found within Ungar and

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because there is no motivation to combine the references, Applicant requests reconsideration and withdrawal of the present rejection.

The deficiencies in the individual applied references are not cured through their combination. Both Condon and Ungar are nonanalogous art. Applicant's claims are directed toward an adhesive tape. By contrast, Condon discloses a multilayered sign blank while Ungar discloses an abrasion resistant laminate used to cover countertops and table tops. Neither of the references constitutes analogous art to Applicant's adhesive tape. Therefore, their combination does not render the Applicant's invention obvious and the rejection should be withdrawn.

Even were Condon deemed analogous art, its deficiencies would not be cured by the application of the Ungar reference. The Condon reference does not disclose all aspects of Applicant's claimed invention, as discussed above. To cure these deficiencies, the Office relies upon the Ungar reference, which itself does not disclose Applicant's claimed invention, also as discussed above. Specifically, the Office cites the use of a rubberized pressure sensitive adhesive in the Ungar reference and applies the teaching of the use of that rubberized pressure sensitive adhesive to the structure shown by the Condon reference. The Office concludes that this renders Applicant's invention obvious. However, the Ungar reference discloses the use of neither a pressure sensitive adhesive in general nor the specific use of a rubberized double sided tape. Applicant's claim 10 distinctly claims an adhesive tape where the "adhesive is a pressure sensitive adhesive." However, though the Ungar reference does show an adhesive layer, there is no teaching or indication that the adhesive layer may comprise a pressure sensitive adhesive, much less a rubberized pressure sensitive adhesive. The Office points to column 8, lines 14-19 as evidence that the Ungar reference teaches the use of a rubberized pressure sensitive adhesive.

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However, Applicant respectfully disagrees with this characterization of this passage – the adhesives listed in that section of the Ungar reference are taught to be merely adhesives, not pressure sensitive adhesives and not rubberized pressure sensitive adhesives.

Because the Ungar reference does not disclose the use of any pressure sensitive adhesive as the adhesive layer, much less the use of a rubberized pressure sensitive adhesive, and because the Condon reference does not teach the use of any rubberized pressure sensitive adhesive, the Ungar reference does not cure the deficiencies found within the Condon reference and does not render that part of the applicant's invention obvious and the rejection should be withdrawn.

As discussed above, the Ungar reference also fails to disclose the use of a double sided tape as the adhesive layer. Applicant's claim 7 clearly claims an adhesive tape where the adhesive layer "comprises a rubberized double-sided tape." Applicant notes the Office's tortured definition of 'double-sided tape' and respectfully submits that the Office's stated understanding of the meaning of 'double-sided tape' is repugnant to that phrase's well known meaning. The Office stated that any adhesive applied to a substrate constituted a double-sided tape because the adhesive layer had two adhesive surfaces. However, Applicant did not claim a double-sided adhesive – Applicant claimed a double-sided adhesive tape, the well known meaning of which is a tape that has two adhesive opposite surfaces. Conversely, by the Office's definition, all adhesive tapes are double-sided adhesive tapes due to the presence of an adhesive layer which, by itself, has two adhesive surfaces, one of which is attached to the adhesive tape's own substrate and the other of which is open to the atmosphere and allows the adhesive tape to be adhered to an external surface. This definition renders the term, 'double-sided tape' useless and goes against the well known meaning of the term. Applicant therefore respectfully submits that the

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Office's applied definition of double-sided tape is incorrect and that the Ungar reference fails to disclose the use of a double-sided tape as the adhesive layer within an adhesive tape. Because there is no disclosure of the use of a double sided tape as an adhesive layer within the Ungar reference, that reference may not be relied upon to cure the lack of a double sided adhesive tape layer within the Condon reference and the combination of these two references does not render Applicant's invention obvious and the rejection should be withdrawn.

Applicant notes that for an obviousness rejection the MPEP requires that the prior art must suggest the desirability of the claimed invention. MPEP 2143.01. It is well settled that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Id. In other words, there must be some objective reason to combine the teachings of the references. Id. Recently the Federal Circuit summarized the law in this area in In re Fulton, 2004 U.S. App. LEXIS 24815 (Fed. Cir., December 2, 2004). There the court noted that, “[s]tated another way, the prior art as a whole must ‘suggest the desirability’ of the combination. In re Beattie, 974 F.2d 1309, 1311 (Fed. Cir. 1992) (internal quotation omitted); Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340 (Fed. Cir. 2000) (‘Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter.’). The source of the teaching, suggestion, or motivation may be ‘the nature of the problem,’ ‘the teachings of the pertinent references,’ or ‘the ordinary knowledge of those skilled in the art.’ In re Rouffet, 149 F.3d at 1355.” In re Fulton.

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Because the Ungar reference does not disclose a rubberized pressure sensitive adhesive and does not disclose a double sided tape used as an adhesive layer, there can be no motivation to combine the references to obtain Applicant's claimed invention. However, even were the Condon and Ungar references deemed to disclose what the Office claims that they disclose, there would be no motivation to combine the references to obtain Applicant's claimed invention. The Ungar reference merely discloses that some adhesives are waterproof and does not give any reason why the addition of such an adhesive to any surface would be advantageous and does not say that such an adhesive would be advantageously used on a multilayer sign blank. Therefore, because there is no motivation to use the adhesive discussed within the Ungar reference in the multilayer sign blank disclosed by the Condon reference, the combination of these references does not render Applicant's invention obvious and the rejection should be withdrawn.

NEW CLAIMS

Moreover, new claims 11 and 12 are believed patentable in light of the references of record. Applicant believes that these new claims will not require an additional search because, even though they have been broadened in certain respects, these new claims recite elements largely contained in the present claims covered by the Examiner's previous search.

CONCLUSION

Applicant, intending to be completely responsive, believes that the amendments and remarks presented above resolve all outstanding issues on the above-referenced application. Accordingly, the application is believed to be in condition for allowance. Early notice thereof is earnestly solicited. While no additional fees are believed due, the Commissioner is hereby

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authorized to charge any necessary additional fees, or credit any overpayment, to Deposit Account No. 02-2051, referencing Attorney Docket No. 29006-2.

Respectfully submitted,

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